

REMARKS/ARGUMENTS

Favorable reconsideration of this application, as presently amended and in light of the following discussion, is respectfully requested.

Claims 1-5 and 7-9 are pending in the present application. Claims 4, 5 and 7 have been amended by way of the present amendment. Support for amendments to the claims can be found in the originally filed disclosure. Thus, no new matter is added.

In the outstanding Office Action, the specification was objected to as including informalities; Claims 1-5 and 7-9 were rejected under 35 U.S.C. §101 as directed to non-statutory subject matter; Claims 1-5 and 7-9 were rejected under 35 U.S.C. §112, second paragraph, as indefinite; and Claims 1, 3-5, 7 and 9 were rejected under 35 U.S.C. §103(a) as unpatentable over Kent (U.S. Pat. Pub. No. 2002/0040374) in view of Nii (U.S. Pat. Pub. No. 2002/0065730).

With respect to the objection to the specification as failing to provide proper antecedent basis for the claimed subject matter, Applicants respectfully traverse this objection. Specifically, MPEP §1302.01 provides that

There should be clear support or antecedent basis in the specification for the terminology used in the claims. Usually, the original claims follow the nomenclature of the specification; but sometimes in amending the claims or in adding new claims, applicant employs terms that do not appear in the specification. This may result in uncertainty as to the interpretation to be given such terms. See MPEP § 608.01(o). **It should be noted, however, that exact terms need not be used in haec verba** to satisfy the written description requirement of the first paragraph of 35 U.S.C. 112. *Eiselstein v. Frank*, 52 F.3d 1035, 1038, 34 USPQ2d 1467, 1470 (Fed. Cir. 1995); *In re Wertheim*, 541 F.2d 257, 265, 191 USPQ 90, 98 (CCPA 1976). See also 37 CFR 1.121(e) which merely requires substantial correspondence between the language of the claims and the language of the specification. (emphasis added).

Moreover, 37 C.F.R. §1.75(d)(1) states

The claim or claims must conform to the invention as set forth in the remainder of the specification and the terms and phrases used in the claims must find clear support or antecedent basis in the description so that the meaning of the terms in the claims may be ascertainable by reference to the description.

In the present case the terms “receiving, storing, managing, reading, arranging and composing” would be clearly ascertainable to one skilled in the art. These generally known terms would not cause confusion for one skilled in the art as the plain meaning of the terms is easily ascertainable. The purpose of the requirement in 37 C.F.R. §1.75(d)(1) is to ensure that the terms recited in the claims are ascertainable and not confusing.

Moreover, Applicants wish to point out that the language “means for receiving”, “means for storing”, etc. appears in the originally filed claims.¹ As such, this language is, by virtue of its existence in the original claims, already part of the originally filed specification.

Thus, as a result, Applicants note that the objection to the specification is improper and respectfully request that the objection be withdrawn.

With regard to the rejection of Claims 1-5 and 7-9 under 35 U.S.C. §101 as directed to non-statutory subject matter, Claims 4, 5 and 7 have been amended to overcome this rejection. With regard to the rejection of Claim 1 under 35 U.S.C. §101, Applicants respectfully traverse this rejection.

Specifically, Claim 1 recites means-plus-function features which must be considered in view of 35 U.S.C. §112, sixth paragraph. A proper analysis under 35 U.S.C. §112, sixth paragraph, requires consideration of the corresponding structure. 35 U.S.C. §112, sixth paragraph, states that claim limitation expressed in means-plus-function language “shall be construed to cover the corresponding structure...described in the specification and equivalents thereof.” A person of ordinary skill in the art would recognize, based on the

¹ See originally filed Claim 1.

present specification, that an example of the “means” described in the specification includes the central processing unit 11 of device 2 shown in Applicants’ Fig. 2, and the algorithm executed by the processor. Thus, the claimed “means” is not software per se, but includes the central processing unit and the algorithm.

In support of this position, Applicants note *WMS Gaming, Inc. v. International Game Technology*, 184 F.3d 1339 (Fed. Cir. 1999), where the Federal Circuit held that the time domain processing means is a microprocessor programmed to carry out the algorithm. In *WMS Gaming*, the Federal Circuit noted the statutory requirement to focus on corresponding structure.

Accordingly, Applicants respectfully request that the rejection of Claims 1-5 and 7-9 under 35 U.S.C. § 101 be withdrawn.

With respect to the rejection of Claims 1-5 and 7-9 under 35 U.S.C. §112, second paragraph, as indefinite, Claims 4, 5 and 7 have been amended to overcome the rejection. With regard to the rejection of Claims 1-3 under 35 U.S.C. §112, second paragraph, Applicants respectfully traverse this rejection.

The outstanding Action states in item “p.” on page 7 that “the written description fails to disclose the corresponding structure, material, or acts for the claimed function.” Applicants respectfully traverse this assertion as clearly erroneous.

For example, with regard to the storing means for storing a plurality of content data corresponding to the at least one order, Applicants respectfully submit that the storage means clearly corresponds to the “storage unit” shown in Figures 2-4 and described on page 11 as formed by a hard disk or the like. Applicants note that structure for each of the means elements recited in Claims 1-3 is clearly found in the disclosure as originally filed.

Thus, Applicants respectfully request that the rejection of Claims 1-5 and 7-9 under 35 U.S.C. §112, second paragraph, be withdrawn.

Addressing now the rejection of Claims 1, 3-5, 7 and 9 under 35 U.S.C. §103(a) as unpatentable over Kent in view of Nii, Applicants respectfully traverse this assertion.

Claim 4 recites, in part,

receiving at least one order corresponding to a genre;
storing a plurality of content data in the computer readable storage medium, the plurality of content data corresponding to the at least one order;
managing, using the information processing apparatus, preference data by which to determine preferences based on a quantity of previous orders, each order corresponding to a genre;
reading said plurality of content data, which is stored to said computer readable storage medium by said storing, in response to an instruction;
arranging, using the information processing apparatus, said plurality of content data read in said reading, in accordance with said preference data managed in said managing; and
composing, using the information processing apparatus, said plurality of content data arranged in said arranging, into a single document including the plurality of content data for display.

Claims 1, 5 and 7 recite means, computer readable storage medium and non-means apparatus claims.

Kent describes a method of producing an individualized publication which gathers information from a plurality of sources and conglomerates the information into a single publication.

However, Kent does not describe or suggest managing, using the information processing apparatus, preference data by which to determine preferences based on a quantity of previous orders, each order corresponding to a genre and arranging, using the information processing apparatus, said plurality of content data read in said reading, in accordance with said preference data managed in said managing.

Nevertheless, the outstanding Action cites Nii as curing the deficiencies of Kent with regard to the claimed invention.

Nii describes a system for tailoring content to be delivered on a terminal-to-terminal basis. Further, Nii describes that the information to be delivered to a particular terminal is determined based on a number of factors including previous items purchased by the potential customer.

However, Nii does not describe or suggest managing, using the information processing apparatus, preference data by which to determine preferences based on a quantity of previous orders, each order corresponding to a genre and arranging, using the information processing apparatus, said plurality of content data read in said reading, in accordance with said preference data managed in said managing.

For example, nothing in Nii describes that each order corresponds to a genre. Further, nothing in Nii describes arranging said plurality of content data in accordance with preference data which is based on a quantity of previous orders.

In other words, Nii describes limiting the content provided to the terminal based on a number of factors including previous items purchased by the potential customer. Similarly, Kent describes limiting the content included in the publication based on preference data. In contrast, the claimed invention does not remove content or limit the content which is displayed. Instead, the claimed invention merely *arranges* said plurality of content data, read in said reading, in accordance with said preference data managed in said managing.

Thus, the claimed invention is able to place content relating to previous orders in a more conspicuous location (such as near the top of the page, for example) while at the same time still displaying content which the combination of Kent and Nii would have removed and never provided to the terminal at all.

Accordingly, the claimed invention has the advantageous feature of enabling a user to discover new content that may be interesting while at the same time providing content which

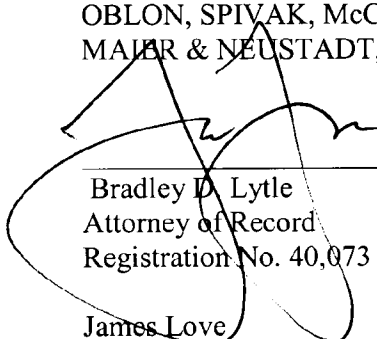
the user has indicated as having a preference for in a conspicuous location on the page. This feature is not provided by the combination of Kent and Nii.

Thus, Applicants respectfully submit that Claim 4 and similarly Claims 1, 5 and 7, and claims depending respectively therefrom, patentably distinguish over Kent and Nii.

Consequently, in view of the above discussion, it is respectfully submitted that the invention defined by Claims 1-5 and 7-9 patentably distinguish over the cited art. The present application is therefore believed to be in condition for formal allowance and an early and favorable reconsideration of this application is therefore requested.

Respectfully submitted,

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